

Page 11  
Application No. 10/634,991  
Amendment Dated: September 7, 2004  
Reply to Office Action mailed May 5, 2004

## REMARKS

After entry of the amendment, claims 1-51 remain pending.

Claims 1-17, 20-37, 41-44, and 46-51 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,688,346 to Brahier et al. (Brahier), in view of U.S. Patent No. 5,298,104 to Absher (Absher). Claims 18, 19, 38-40, and 45 are rejected under 35 U.S.C. §103(a) as being unpatentable over Brahier and Absher, and further in view of U.S. Patent No. 5,771,657 to Lasher et al. (Lasher).

### A. The Claimed Invention

One aspect of the claimed invention is directed to systems and methods for placing a label that corresponds to a particular order on a bag. In particular, embodiments of the invention can be utilized to print, for example, a label containing name and address information of a recipient of a prescription order, and place the label on a bag that is to be delivered to the recipient. See, for example, page 16, lines 3-20; page 29, lines 10-21; and page 46, lines 3-10.

Additional features of the invention include, for example, a sensor to detect a position of a perforation between bags (claims 5 and 23), which advantageously can be used to convey a bag a predetermined amount (claims 6 and 24). A further feature of the present invention pertains to a first plurality of rollers that rotates in a second direction subsequent to sealing the bag to break a perforation between the bag and a second bag (claims 8 and 26). Yet another feature of the invention places in an opened bag a pharmaceutical container with enclosed pharmaceuticals, corresponding to a prescription order associated with the bag label (claim 37).

### B. U.S. Patent No. 6,688,346 to Brahier

Brahier discloses a "device for feeding, printing and loading a bag from a continuous strip of bags with a desired product to be packaged." (column 2, lines 38-40). With regard to printing, Brahier discloses that "[t]he print head 24 thermally applies the required information to each individual bag as the bag moves through the printer assembly 12." (column 4, lines 13-16, emphasis added).

Page 12  
Application No. 10/634,991  
Amendment Dated: September 7, 2004  
Reply to Office Action mailed May 5, 2004

In distinct contrast to the claimed invention of the present application, Brahier thus discloses a system in which information is **printed directly on a bag**. In particular, Applicants note that each of the independent claims (1, 3, 5 and 8) of Brahier recite that information is printed “on each individual bag.” (emphasis added). In contrast to Brahier, embodiments of the claimed invention of the present application recite, for example, “a printer for **printing a plurality of labels, each label containing information corresponding to a particular order**, disposed on a backing material.”

#### C. U.S. Patent No. 5,298,104 to Absher

Absher is directed to applying “high quality coupons to bags so that the coupons are attractive to the consumer yet are easily removable and do not stick to the hands, handbag, wallet, or purse of the consumer.” (column 2, lines 21-24). With regard to the coupons, Absher discloses that the coupons “may represent, for example, an ordinary store coupon, a label, or a sticker, which may be placed upon the bag,” and that “different coupons may be sequentially applied to different bags being formed in the same manufacturing line to prevent **inundating the marketplace with just a single coupon**.” (column 5, lines 24-26; column 5, lines 59-62, emphasis added).

In contrast to the claimed invention, Absher thus discloses a system in which mass-produced coupons are placed on a bag. Absher does not teach or suggest, let alone disclose, that any of the mass-produced coupons placed on a bag contain “information corresponding to a particular order.”

#### D. The Rejections Under 35 U.S.C. §103(a)

Although Brahier discloses a system that prints material directly on a bag (on page 2 of the Office Action the Examiner refers to this as “places a label (print) on a bag”), and Absher discloses a system that places mass-produced coupons on a bag, Applicants note that Brahier and Absher, alone or in combination, operate in a fundamentally different way than the claimed invention. Specifically, neither Brahier nor Absher teach or suggest, let alone disclose “a printer for printing a plurality of labels...disposed on a backing material,” as recited in independent

Page 13  
Application No. 10/634,991  
Amendment Dated: September 7, 2004  
Reply to Office Action mailed May 5, 2004

claims 1, 20, 50 and 51. Accordingly, neither Brahier nor Absher teach or suggest, let alone disclose “a printer for printing a plurality of labels, **each label containing information corresponding to a particular [prescription] order**, disposed on a backing material,” as recited in independent claims 1, 20, 50 and 51. Accordingly, and for at least these reasons, the combination of features recited in claims 1, 20, 50 and 51, when interpreted as a whole, is submitted to patentably distinguish over the prior art.

In addition, claim 1 recites, for example, “a label removal and tamp mechanism that receives at least one printed label containing information corresponding to a particular order.” Since neither Brahier or Absher, alone or in combination, teach or suggest printed labels “containing information corresponding to a particular order,” it follows that neither Brahier nor Absher teach or suggest, let alone disclose, “a label removal and tamp mechanism that receives at least one printed label containing information corresponding to a particular order.” Accordingly, and for at least these reasons, the combination of features recited in claim 1, when interpreted as a whole, is further submitted to patentably distinguish over the prior art.

Moreover, claim 1 recites, for example, “a label removal and tamp mechanism that...selectively removes the printed label containing information corresponding to the particular order from the backing material, and places the printed label on the bag.” Accordingly, and for at least these reasons, the combination of features recited in claim 1, when interpreted as a whole, is submitted to patentably distinguish over the prior art.

Dependent claims 2-19 recite allowable subject matter not only by virtue of their dependency from claim 1, but also because of additional features they recite. For example, claims 5 and 6 recite “a third sensor for **detecting a position of a perforation** between the bag and a second bag.” With regard to the Examiner’s remarks on page 3 of the Office Action pertaining to claim 5, Applicants note that col. 6, lines 58-59 of Brahier disclose a sensor that indicates that a next bag can be printed subsequent to tearing. Applicants submit that is not the same as “detecting a position of a perforation,” as recited in claim 5. Accordingly, and for at least this reason, the combination of features recited in claims 5 and 6, when interpreted as a whole, is submitted to patentably distinguish over the prior art.

Claim 8 recites “at least a portion of said first plurality of rollers rotates in a second direction subsequent to sealing the bag to break a perforation between the bag and a second bag.” With

Page 14  
Application No. 10/634,991  
Amendment Dated: September 7, 2004  
Reply to Office Action mailed May 5, 2004

regard to the Examiner's remarks on page 3 of the Office Action pertaining to claim 8, Applicants note that col. 6, lines 58-59 of Brahier disclose that the bag is torn along a perforation. Brahier does not disclose that "at least a portion of said first plurality of rollers rotates in a second direction subsequent to sealing the bag to break a perforation between the bag and a second bag," as recited in claim 8. Accordingly, and for at least these reasons, the combination of features recited in claim 8, when interpreted as a whole, is submitted to patentably distinguish over the prior art.

Claims 12-15 recite that "at least one of said second plurality of rollers is under a biasing force." Applicants find no teaching or suggestion, let alone disclosure, in either Brahier or Absher regarding a "biasing force." In fact, Brahier does not disclose a "second plurality of rollers (as Brahier does not print on labels, but instead prints directly on a bag). In addition, Applicants find no teaching or suggestion in Brahier or Absher regarding a "spring" (claim 13), a "cam" (claim 14), or a "switch" (claim 15). Accordingly, and for at least these reasons, the combination of features recited in claims 12-15, when interpreted as a whole, is submitted to patentably distinguish over the prior art.

Claim 16 recites that "while a first bag is being tamped, a second bag is substantially simultaneously being opened by said at least one bag opening mechanism." Applicants note that Brahier teaches against this feature of the claimed invention. In particular, Brahier discloses that "each bag is loaded with a product prior to the printing of another bag. (See, e.g., Abstract, emphasis added). In contrast, claim 16 of the present invention recites a bagging scenario where "a first bag is being tamped" (and thus has a label printed), a second bag is "simultaneously being opened" (and thus is not loaded with product). Accordingly, and for at least these reasons, the combination of features recited in claim 16, when interpreted as a whole, is submitted to patentably distinguish over the prior art.

Applicants note that U.S. Patent No. 5,771,657 to Lasher does not compensate for the deficiencies of Brahier and Absher discussed above.

Independent 20 has been amended in a manner analogous to that of claim 1. Accordingly, claim 20 recites allowable subject matter for substantially the same reasons as claim 1. Dependent claims 21-36 recite allowable subject matter not only by virtue of their dependency

Page 15  
Application No. 10/634,991  
Amendment Dated: September 7, 2004  
Reply to Office Action mailed May 5, 2004

from claim 20, but also because of additional features they recite. For example, dependent claims 23, 24, 26, and 30-33 respectively correspond to dependent claims 5, 6, 8 and 12-15, and thus recite allowable subject matter for substantially the same reasons discussed above. Accordingly, and for at least these reasons, the combination of features recited in claims 20-36, when interpreted as a whole, is submitted to patentably distinguish over the prior art.

On page 4 of the Office Action, the Examiner takes the position with regard to claim 37 that "the modified system and method of Brahier et al., as mentioned above, disclose all the claimed limitations." Claim 37 recites "**printing on a label** for each of the plurality of bags, the **name and address information of a recipient of a prescription order.**" Accordingly, claim 37 recites allowable subject matter for substantially the same reasons as claim 1. Dependent claims 38-49 recite allowable subject matter not only by virtue of their dependency from claim 37, but also because of additional features they recite. For example, dependent claims 42, 45, and 49 respectively correspond to dependent claims 6, 8, and 16, and thus recite allowable subject matter for substantially the same reasons discussed above. Accordingly, and for at least these reasons, the combination of features recited in claims 37-49, when interpreted as a whole, is submitted to patentably distinguish over the prior art.

Independent claim 50 has been amended in a manner analogous to claim 1. Accordingly, claim 50 recites allowable subject matter for substantially the same reasons as claim 1.

Independent claim 51 has been amended in a manner analogous to claim 1. Accordingly, claim 51 recites allowable subject matter for substantially the same reasons as claim 1.

It should be understood that the bold facing and/or underlining of words has been done merely for emphasis in explaining various aspects of the present invention and cited art, and is in no way meant to limit the scope of the claims.

Page 16  
Application No. 10/634,991  
Amendment Dated: September 7, 2004  
Reply to Office Action mailed May 5, 2004

### Conclusion

Applicants respectfully submit that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. Applicants do not concede that the cited prior art shows any of the elements recited in the claims. However, Applicants have provided specific examples of elements in the claims that are clearly not present in the cited prior art.

Applicants strongly emphasize that one reviewing the prosecution history should not interpret any of the examples Applicants have described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, Applicants assert that it is the combination of elements recited in each of the claims, when each claim is interpreted as a whole, that is patentable. Applicants have emphasized certain features in the claims as clearly not present in the claims, as discussed above. However, Applicants do not concede that other features in the claims are also not missing in the prior art. Rather, for the sake of simplicity, Applicants are providing examples of why each of the claims described above are distinguishable over the cited prior art.

For all the reasons advanced above, issuance of a Notice of Allowance is respectfully requested.

Page 17  
Application No. 10/634,991  
Amendment Dated: September 7, 2004  
Reply to Office Action mailed May 5, 2004

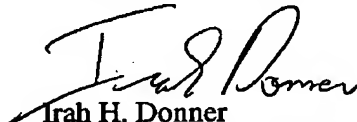
Authorization

The Commissioner is hereby authorized to charge any additional fees that may be required for this Amendment, or credit any overpayment to deposit account no. 08-0219.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to deposit account no. 08-0219.

Respectfully submitted,

WILMER CUTLER PICKERING HALE AND DORR LLP

  
Ira H. Donner  
Registration No. 35,120

Date: 9/7/04

WILMER CUTLER PICKERING HALE AND DORR LLP  
300 Park Avenue  
New York, NY 10022  
Phone: (212) 937-7246  
Fax: (212) 937-7300